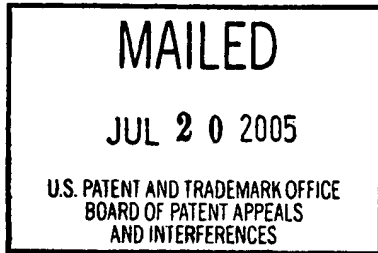


UNITED STATES PATENT AND TRADEMARK OFFICE



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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KURT CLEMENT

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Application 09/518,787

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was electronically received at the Board of Patent Appeals and Interferences on July 19, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith electronically returned to the examiner. The matters requiring attention prior to docketing are identified below.

On June 10, 2004, appellant filed a Notice of Appeal. On September 9, 2004, an Appeal Brief was filed. On August 12, 2004, the "Rules of Practice before the Board of Patent Appeals and Interferences" were printed in the Federal Register (69 Fed. Reg. 49959, final rule). These rules became effective on September 13, 2004. On December 2, 2004, an Examiner's Answer was mailed in response to the Appeal Brief. In the Appeal Brief

mailed December 2, 2004, the examiner states that he has included a new ground of rejection. See page 3 of the Examiner's Answer. In order to implement a new ground of rejection, the examiner must follow the guidelines set forth in training material entitled "Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule," located at the following URL:

[www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html](http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html)

The training material states:

A new ground of rejection is now permitted in an examiner's answer mailed on or after September 13, 2004 (§41.39(a)(2)).

A new ground of rejection should be rare, rather than a routine occurrence.

Any new ground of rejection made in an answer must be:

Approved by a Technology Center Director or designee; and

1. Prominently identified, (e.g., a separate heading with all capitalized letters) in the following sections of the answer:

Grounds of Rejection to be Reviewed on Appeal section; and

Grounds of Rejection section.

As can be seen from the Examiner's Answer mailed December 2, 2004, the examiner has met complied with the requirement of

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specifically identifying the new ground of rejection. However, the new ground of rejection was not approved by the Technology Center Director. Appropriate correction is required.

In addition, it is noted that appellant filed an Information Disclosure Statement (IDS) on June 8, 2000. However, there is no indication on the electronic record, that the examiner has considered the IDS filed June 8, 2000. Appropriate correction is required.

Accordingly,

ORDERED that the application is returned to the examiner:

1. to vacate the Examiner's Answer mailed December 2, 2004;
2. to mail a new Examiner's Answer that has the new ground of rejection approved by the Technology Director;
3. to consider the IDS filed June 8, 2000;

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4. written notification to appellant of said  
consideration; and

5. for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By: 

DALE M. SHAW

Program and Resource Administrator  
(571) 272-9797

dms/DMS

cc: Perkins Coie LLP  
Patent-Sea  
P.O. Box 1247  
Seattle, WA 98111-1247